UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,666	12/27/1999	KEITH C. THOMAS	98-1176	9062

32718 7590 08/29/2003

GATEWAY, INC.
14303 GATEWAY PLACE
ATTENTION: MARK S. WALKER (MAIL DROP SD-21)
POWAY, CA 92064

EXAMINER	
KEMPER, MELANIE A	
ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/472,666	THOMAS, KEITH C.	
	Examiner	Art Unit	
	M Kemper	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-54* is/are pending in the application.

4a) Of the above claim(s) *40-54* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Applicant's election with traverse of Group I in Paper No. 14 is acknowledged. The traversal is on the ground(s) that there is no serious burden and that the classification definitions do not apply. This is not found persuasive because due to the divergent subject matter, the examiner would have to perform separate searches for each claimed concept which poses a burden. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 40-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 14.

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 19-39 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ebisawa, patent number 5,946,664.

Ebisawa teaches a removable moving media comprising: a source content (video game); a removable content disposed within the source content (col. 3, lines 58-60); a

communication assembly in connection with a virtual product source providing access to the source content and the removable content (col. 3, lines 20-35, col. 5, lines 12-21, 30-35, col. 6, lines 10-20, 35-38, col. 6, line 50- col. 8, line 25); wherein the communication assembly allows the virtual product source to place a virtual product within the removable moving media through utilization of the removable content disposed within the source content (col. 3, lines 58-60). Ebisawa also teaches a method for placement of virtual product in a moving media, comprising selecting an original source media including a removable content, the removable content providing a virtual product location (col. 3, lines 20-35, col. 5, lines 12-20, col. 7, lines 30-67); receiving a virtual product content from a peripheral virtual product source (col. 7, lines 1-10, 30-67, col. 5, lines 12-20, col. 6, lines 12-19, lines 35-38); editing the original source media and inserting the virtual product content in the virtual product location of the original source media (col. 3, lines 50-60, col. 7, lines 10-25). Ebisawa also teaches a system for placing virtual products within a moving media comprising an original moving media content source including a removable content, the removable content providing a virtual product location (col. 3, lines 20-35); a network in communication with the original moving media content source, the network providing a virtual product source (figs, 7-9 and related text, col. 5, lines 12-20); a virtual product disposed within the virtual product source, the virtual product being enabled for placement in the virtual product location of the removable content (advertisements described); wherein the virtual product is downloaded from the network and placed on

the moving media in the virtual product location (col. 5, lines 12-20, lines 60-65, col. 3, lines 20-35, 55-60).

Ebisawa also teaches the virtual product source is at least one of a network and a peripheral computing system (col. 3, lines 60-65, col. 5, lines 12-20, figs. 7-9 and related text); the virtual product source updates the virtual product location on the removable content within the source content (col. 5, lines 35-50); the source content is a video game (col. 1, lines 15-20) wherein the source content is at least on of a streaming video or video stream and a video file format (col. 7, lines 12-20, 50-60); the source content is a digital source content (col. 5, line 60 – col. 6, line 20). In this case, a virtual product refers to any object which is replaced or replaces in a scene for the purposes of providing advertising. To the extent that the claim to a virtual product may be interpreted differently, it would have been obvious to one having ordinary skill in the art at the time of the invention to have used a virtual product in Ebisawa since product placement is well known in the art for product exposure and advertisement purposes and would have been adopted for the intended use of the artistic choices of the game manufacturer and sponsor(s). It also would have been obvious to have the virtual product placed within the moving media through a paint process since this would have been adopted for the intended use of providing static advertisements such as on the billboard of Ebisawa.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 20, 29, 33-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims directed to the virtual product source is a network or a website on a network is unsupported by the original specification. The applicant is required to show where the virtual product source is a network or a website on a network or cancel the claims. No new matter may be introduced into the claims or the specification.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Margulis, patent number 6,456,340 teaches product placement in video (col. 16, line 59 – col. 17, line 3). Sheasby et al., patent number 6,473,094 teaches digital editing of post-production works (summary).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

M Kemper
Primary Examiner
Art Unit 3622

MK